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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/092,260	03/07/2002	Giorgio Trani	0695-0118P	9700
2292	7590	06/15/2004	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			RHEE, JANE J	
			ART UNIT	PAPER NUMBER
			1772	

DATE MAILED: 06/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/092,260

Applicant(s)

TRANI ET AL.

Examiner

Jane J Rhee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 46 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 46 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

Rejections Withdrawn

1. The 35 U.S.C. 102 (b) of claim 45 anticipated by Gifford et al. has been withdrawn due to applicant's amendment in response 3/29/2004.

Rejections Repeated

2. The 35 U.S.C. 112, 2nd paragraph has been repeated for the reasons previously stated in Paper 4.

Response to Arguments

3. Applicant's arguments filed 3/29/2004 have been fully considered but they are not persuasive.

In response to applicant's argument that US patent number 3648884 obtains different finality, applicant is correct since the reference used to reject the pending claim is US patent number 3648834. Assuming that the applicant had a typographical error and meant US patent number 3648834, the finality of applicant's product is not different from US patent '834. Applicant's film described in claim 46 is an intermediate product wherein the film is rewindable comprising an inert transformable substance and an inert activator wherein the substance and activator are able to form an agglomerate with the film so when the activator is energized the film transforms to a structurally stable object. The final product of applicant's invention is the structurally stable object, which is the same final product as the rigid film of US patent '834.

However, applicant claims an intermediate product of a rewindable flexible film comprising an inert transformable substance and an inert activator wherein the

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substance and activator are able to form an agglomerate with the film. US patent '834, inventor Gifford et al. also relates to a flexible film comprising an inert transformable substance and passive activator (col. 1 line 62), which is inert with respect to the film and when the film is subjected to a controlled amount of irradiation from a high energy source the plasticizer is crosslinked or polymerized so as to convert the flexible film extruded therewith into a rigid film (col. 1 lines 65-66). If the film were not subjected to a high energy source, then the film would remain in its original state which is a flexible film (col. 2 lines 10-11). As to the flexible film being rewindable, "the fact that appellant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious." Ex parte Obiaya, 227 USPQ 58,60 (1989). A flexible film is notoriously well known in the art to be capable of being rewindable as to rewind upon a reel. Therefore, the intermediate product of Gifford et al., a flexible film comprising an inert transformable substance and passive activator (col. 1 line 62), which is inert with respect to the film is the same intermediate product claimed by the applicant, a film that is rewindable comprising an inert transformable substance and an inert activator wherein the substance and activator are able to form an agglomerate with the film so when the activator is energized the film transforms to a structurally stable object.

Thus, in the absence of any evidence to the contrary, it remains the Examiner's position that the claimed invention is rendered obvious over the prior art of record discussed above.

New Rejection

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 46 is rejected under 35 U.S.C. 103(a) as being unpatentable by Gifford et al. (3648834) in view of Huguenin (5832698).

Gifford et al. discloses a flexible film for obtaining structurally stable objects, the film being at least partially associated with a structurally transformable substance (col. 1 line 61) and a passive activator (col. 1 line 61) which is both inert with respect to the film, the activator and the substance being able to form an agglomerate with the film, the activator when energized starting a structurally transformation of the substance (col. 1 lines 61-66).

Gifford et al. fail to disclose that the flexible film is rewindable. Huguenin teaches that a flexible film is notoriously well known in the art to be capable of being rewindable as to rewind upon a reel as shown in figure 1 number 2 for the purpose of being a primary supply roll of sheets (col. 2 line 33).

Therefore, it would have been obvious to one having ordinary skill in the art at the time applicant's invention was made to provide a rewindable flexible film in order to be a primary supply roll of sheets (col. 2 line 33) as taught by Huguenin.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jane J Rhee whose telephone number is 571-272-1499. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser Ahmad can be reached on 571-272-1487. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jane Rhee
June 4, 2004


NASSER AHMAD
PRIMARY EXAMINER 6/10/04